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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,386	12/28/1999	MARIO GUILLEN	BAL6019P0090	9922

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EXAMINER	
HWU, JUNE	

ART UNIT	PAPER NUMBER
1661	

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/473,386	GUILLEN, MARIO	
	Examiner	Art Unit	
	June Hwu	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed November 28, 2003 has been entered.

Applicant has canceled claims 1-30 and added claims 31-34.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 31-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of crossing the proprietary *Impatiens flaccida* plant disclosed on page 4 with a *I. hawkeri* Java series and selecting an interspecific plant with a trailing habit, does not reasonably provide enablement for all lines of *I. flaccida*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The specification discloses a single cross was made by crossing the proprietary I. *flaccida alba* with *I. hawkeri* (pages 4-5) but does not describe whether this method of breeding an interspecific impatiens with a trailing habit will occur outside of their proprietary impatiens line. There is no known prior art that shows viable plants were produced from crossing *I. flaccida* with *I. hawkeri*. As noted by the Applicant on page 3 of the specification, Arisumi (1980) and Arisumi (1985) state that no seedling were obtained form crossing *I. flaccida alba* with *I. herzogii*. Since these findings show that no plants were recovered from crossing *I. flaccida alba* with a species of New Guinea impatiens, then one cannot assume that Applicant's own experiment would always work without Applicant's proprietary impatiens line deposited at the

American Type Culture Collection. It is unclear if the proprietary line of *I. flaccida* Linda Vista breeding selection was deposited at the depositary. Since the specification is enabled for the method of using from the proprietary line, then that is what should be deposited. If the deposited *I. flaccida* line is not the same line referenced in the specification, then the claims are not enabled for any embodiment. Given the breadth of the claim, the state of the prior art, the predictability in the art, the existence of working examples, and the quantity of experimentation needed to make and use the invention, it would require undue experimentation for one skilled in the art to make and use the full scope of the claimed invention.

To obviate this rejection, it is suggested that the Applicant provide evidence that this method of breeding interspecific impatiens plants with a trailing habit can occur with other lines of *I. flaccida*.

Response to Arguments

35 USC § 112, first paragraph

Enablement

Applicant's arguments filed November 28, 2003 have been fully considered but they are not persuasive.

Applicant argues that it is not necessary to provide a number of experimentations to practice the invention. Applicant continues to argue that the "key word is 'undue' not experimentation". Examiner agrees that it is not necessary to provide any experimentation, but it is important if the experimentation is necessary then it is undue. A considerable amount of experimentation would be necessary because the method of crossing the two Impatiens species is apparently not always successful. Quantity of experimentation is one of the *Wands* factors.

Applicant argues that the enablement rejection is not properly applied because only three of the *Wand* factors were disclosed in the Office Action. This argument has been fully considered, however, is not persuasive because all of the *Wand* factors were considered but the most pertinent factors were described in the rejection. If, however, the Applicant feels the breadth of the claims, the nature of the invention, the level of one of ordinary skill, and the amount of direction provided by the inventor are important then he should explain why they are essential. Applicant also stated that only three *Wand* factors were listed in the last Office Action dated August 23, 2003, but the amount of experimentation is cited on page 4.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

JH

Bruce Campell

BRUCE R. CAMPELL, PH.D
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